(3)

In the Supreme Court

OF THE

United States

OCTOBER TERM, 1925

No. [redacted] 174

CARL FRANZ ADOLF OTTO LAGERHOLM,
Petitioner,

vs.

WALTER E. OLSEN & CO., INC.,
Respondent.

NOTICE OF MOTION, MOTION, PETITION FOR WRIT OF CERTIORARI

to the Supreme Court of the Philippine Islands,

and

BRIEF IN SUPPORT THEREOF.

JOSEPH C. HUTCHESON,
Hunter Building, San Francisco,
Attorney for Petitioner.

Law Printing Co., San Francisco.

Subject Index

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In the Supreme Court
OF THE
United States

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No.

CARL FRANZ ADOLF OTTO INGENOHL,
Petitioner,

vs.

WALTER E. OLSEN & CO., INC.,
Respondent.

NOTICE OF MOTION FOR WRIT OF CERTIORARI
to the Supreme Court of the Philippine Islands.

To the respondent above named and its attorneys:

Please take notice that on the 5th day of October, 1925, at the opening of Court on that day, or as soon thereafter as counsel may be heard, Carl Franz Adolf Otto Ingenohl, petitioner herein will, upon his petition and copies of the entire record in this cause, submit a motion, a copy of which and of the petition for writ of certiorari and brief in support thereof are herewith delivered to you,

to the Supreme Court of the United States, in its Courtroom, at the Capitol, in the City of Washington, District of Columbia.

Dated, San Francisco,
July 11, 1925.

JOSEPH C. MEYERSTEIN,
Attorney for Petitioner.

In the Supreme Court
OF THE
United States

OCTOBER TERM, 1925

No.

CARL FRANZ ADOLF OTTO INGENOHL,
Petitioner,

vs.

WALTER E. OLSEN & CO., INC.,
Respondent.

MOTION FOR WRIT OF CERTIORARI
to the Supreme Court of the Philippine Islands.

To the Honorable William Howard Taft, Chief Justice and the Associate Justices of the Supreme Court of the United States:

Now comes Carl Franz Adolf Otto Ingenohl and moves this Honorable Court that it shall by certiorari directed to the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the Philippine Islands require said Court to certify to this Court for its review and determina-

tion a certain case in said Supreme Court of the Philippine Islands pending, wherein your petitioner was respondent and the respondent Walter E. Olsen & Co., Inc., was appellant; and to that end petitioner now tenders herewith his petition and brief with a certified copy of the entire record in said cause in said Supreme Court of the Philippine Islands.

Dated, San Francisco,
July 11, 1925.

JOSEPH C. MEYERSTEIN,
Attorney for Petitioner.

In the Supreme Court
OF THE
United States

OCTOBER TERM, 1925

No.

CARL FRANZ ADOLF OTTO INGENOHL,
Petitioner,

vs.

WALTER E. OLSEN & CO., INC.,
Respondent.

PETITION FOR WRIT OF CERTIORARI
to the Supreme Court of the Philippine Islands.

To the Honorable William Howard Taft, Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your petitioner, Carl Franz Adolf Otto Ingenohl, respectfully prays for a writ of certiorari to review the judgment of the Supreme Court of the Philippine Islands in the case of Carl Franz Adolf Otto Ingenohl, plaintiff and appellee, v. Walter E. Olsen & Co., Inc., defendant and appellant. The decision

of the Supreme Court of the Philippine Islands was promulgated on the 12th day of January, 1925, and was entered as a final judgment on the 26th day of January, 1925. Your petitioner, in compliance with Rule 37, Section 3 of this Court submits the following:

I.

SUMMARY AND SHORT STATEMENT OF THE MATTER INVOLVED.

The petitioner Ingenohl is, and for many years prior to all of the happenings in this case was, a citizen and resident of the City of Antwerp, in the kingdom of Belgium. He occupied the position of "gerant" or "gestor" of a Belgian association or corporation, which for many years operated a cigar factory and business in the City of Manila, Philippine Islands, and likewise in the City of Hongkong, Colony of Hongkong. For all the purposes of this case he may be assumed to have been the actual owner of both businesses. The cigars manufactured in the factories referred to were purveyed to the public in the Philippine Islands and more largely in China and the Straits Settlements under established trade marks. These trade marks were registered in the Philippine Islands many years prior to the seizure of the Manila business as hereinafter related and likewise in the Colony of Hongkong and in a number of other countries, including Belgium and the United States. As registered and used in Hongkong, the trade marks contained words indicating that the Hongkong business was a branch

of the Manila business. Some time prior to December 27, 1918, (exactly when does not appear, nor does it appear whether or not Antwerp was at the time enemy occupied territory) Ingenohl's factory and other assets in the City of Manila were seized by the Alien Property Custodian of the United States by virtue of a power claimed under the provisions of the Trading with the Enemy Act of October 16, 1917, as amended, and thereafter on the 25th day of January, 1919, sold to the respondent here for 2,350,000 pesos. A bill of sale was executed by the Alien Property Custodian to the respondent here specifically describing the tangible assets so sold and likewise including in general terms the goodwill and trade marks of the business so sold. Ingenohl's Hongkong factory and business remained in his control and he continued to operate the same and to sell the product of his factory in Hongkong and elsewhere in China under the trade marks which had been registered in the Colony of Hongkong. The purchaser of the Manila business, respondent here, claimed the right as purchaser of the Manila business to sell cigars manufactured in its Manila factory in the Colony of Hongkong and elsewhere in China and the Straits Settlements under the same trade marks. Ingenohl thereupon brought an action in the Supreme Court of Hongkong (a Court of first instance and of general jurisdiction) to establish his right as the sole proprietor in Hongkong of the trade marks and to restrain the defendant from selling there its

cigars in boxes or packages bearing thereon the said trade marks. After a regular trial, both parties duly appearing and being represented by counsel and submitting evidence, the Supreme Court of Hongkong duly gave and made its judgment on the 5th day of May, 1922, adjudging Ingenohl to be the sole proprietor of the trade marks in Hongkong and restraining defendant accordingly from the sale of cigars in boxes or packages bearing thereon the said trade marks. This judgment carried costs duly taxed and allowed in the sum of $26,244.23 Hongkong currency (equal to 31,099.41 pesos, Philippine currency) and through failure of defendant to appeal became final. Thereafter Ingenohl commenced an action against the respondent here in the Court of First Instance of Manila to recover the costs awarded him by the Hongkong judgment. In this action the respondent here appeared and by answer and counterclaim denied Ingenohl's right to recover the costs awarded under the Hongkong judgment, challenged the validity and finality of that judgment, claimed the right under the law of the Philippine Islands to repel the judgment for clear mistake of law and fact and so to retry the issues which had been decided by the Hongkong Court, and upon such retrial recover damages from Ingenohl for violation of its rights in the trade marks laid in the sum of a million pesos. The Manila Court of First Instance upheld the finality of the Hongkong judgment and gave judgment for Ingenohl, pursuant to the prayer of his complaint.

Respondent here appealed from this judgment to the Supreme Court of the Philippine Islands and that Court reversed the judgment of the Court of First Instance of Manila, holding that under the provisions of Section 311 of the Code of Civil Procedure of the Philippine Islands the Hongkong judgment could be repelled for a clear mistake of law or fact, that it was not binding in the Philippine Islands because the Hongkong judgment was the result of a clear mistake of law and fact; that the respondent here is the exclusive owner of the trade marks and entitled to their exclusive use and enjoyment not only in the Philippine Islands but in all other countries and that therefore Ingenohl is not entitled to recover the costs assessed by the Hongkong Court. The Supreme Court of the Philippine Islands further decided that the respondent here was not entitled to recover on its counterclaim for damages for reasons which are not pertinent here.

It appears from the answer filed by the respondent here that the value of the trade marks in question in China is one million pesos and likewise it appears by affidavit of a competent witness made a part of the record here that the value of these trade marks in Hongkong (the value in controversy) exceeds $25,000. The case is one, therefore, which it is competent for this Court to certify to itself for review and determination. Jurisdiction may likewise be entertained by this Court upon the ground that Section 311 of the Code of Civil Pro-

cedure of the Philippine Islands conflicts with a right or privilege of the United States. There follows a brief exposition of the grounds for asserting that the case exhibits impelling reasons for the exercise of this jurisdiction in both of its phases.

II.

GENERAL REASONS RELIED ON FOR ALLOWANCE OF WRIT.

1. An international question, a question of international comity and a question of international law are involved because there is involved in the decision of the Supreme Court of the Philippine Islands the question of the faith and credit which judgments of English Courts shall be given in Courts of the United States and its dependencies. The Supreme Court of Hongkong is the Court of an English colony, administering justice in accordance with the enlightened principles of jurisprudence followed by the Courts of England and by our own Courts. The Supreme Court of the Philippine Islands not only undertakes to deny to the judgment of a Court of a foreign state administering the same system of jurisprudence as our own Courts and having jurisdiction of the parties and without imputation of fraud or misrepresentation, the full faith, credit and finality which would be accorded to the judgment of one of our Courts in England or its colonies; but the Court undertakes to challenge that judgment although it is in accord with the law as expounded by our own Courts, and

where if it could be said to have erred at all, it certainly cannot be said to have erred to such a degree that the error is tantamount to a clear mistake of law or fact.

Important as the question is standing alone, it assumes an additional gravity when viewed in the light of the geographical contiguity of the Philippine Islands to Hongkong and other British jurisdictions in the Far East, such as the Straits Settlements, India and the International Settlement of Shanghai, with steady commercial and social exchanges necessarily involving frequent judicial determinations of the rights of the respective nationals of these localities, which, if the judgment of the Supreme Court of the Philippines is allowed to stand, will lack the finality essential to the orderly administration of justice in matters of private international law.

2. Section 311 of the Code of Civil Procedure of the Philippine Islands, by virtue of which the Supreme Court of the Philippine Islands undertook to inquire into the correctness of the Hongkong judgment, is in conflict with the established law and policy of the United States. This section provides that a foreign judgment *in personam* "may be repelled by evidence of a want of jurisdiction, want of notice to the party, collusion, fraud or clear mistake of law or fact". This section was copied from Section 1915 of the Code of Civil Procedure of the State of California as it stood prior to 1907. The California statute was amended in 1907 so as to

give full faith and credit to foreign judgments, in order to bring the law of that state into consonance with the principles established by this Court. In *Hilton v. Guyot,* 159 U. S. 113, the vexatious question was set at rest and there was established for all time as a principle to be followed by the Courts of this country and its dependencies until changed by statute or treaty the principle

> "that where there has been an opportunity for a full and fair trial abroad before a court of competent jurisdiction conducting the trial upon regular proceedings, after due citation or voluntary appearance of the defendant, and under a system of jurisprudence likely to secure an impartial administration of justice between the citizens of its own country and those of other countries, and there is nothing to show either prejudice in the court or in the system of laws under which it was sitting, or fraud in procuring the judgment, or any other special reason why the comity of this nation should not allow it full effect, the merits of the case should not, in an action brought in this country upon the judgment, be tried afresh, as on a new trial or an appeal, upon the mere assertion of the party that the judgment was erroneous in law or in fact."

As the Courts of England allow under the circumstances embraced in the announcement of the principle full faith and credit to the judgments of our own Courts and as no statute of the United States nor any treaty with England has changed the rule either expressly or by intendment, it was not competent for the legislature of the Philippine Islands to adopt a statute conflicting with the law of its

mother country; and the principle just stated is more than a mere principle of comity; it is a law—an international law and therefore "part of our law", as so declared by this Court in the case just cited. The seriousness of this question was given clear expression in the dissenting opinion of two of the justices of the Supreme Court of the Philippine Islands.

3. Not only was there no clear mistake of law or fact in the judgment pronounced by the Hongkong Court, but the judgment was a proper expression of the law applicable to the facts as declared by the highest Court of the British Empire and by this Court. The trade marks appurtenant to and used in Ingenohl's Hongkong business and factory were not and could not be affected by a sale of Ingenohl's property in the United States or its dependencies made by the Alien Property Custodian of the United States. The acts of the Alien Property Custodian of the United States did not and could not have any extra territorial effect irrespective of whether the language of the bill of sale did or did not purport to carry the trade marks without the territorial limits of the Philippine Islands. Ingenohl at the time of the sale and thereafter was operating a cigar factory in Hongkong and using in connection therewith trade marks duly registered in that colony; and he could not be divested of his rights to use these trade marks in conjunction with the output of his Hongkong factory by virtue of any act of an administrator, governmental or other-

wise, acting under the authority of a foreign government in a foreign land. This is the rule laid down by the House of Lords in *Lecouturier v. Rey* (1910), A. C. p. 265 and by this Court in *Baglin v. Cusenier Co.*, 221 U. S. 580.

Your petitioner furnishes, as an exhibit to this petition, a certified copy of the transcript of the record of said case, including all proceedings in the Supreme Court of the Philippine Islands.

Wherefore your petitioner respectfully prays that a writ of certiorari may be issued out of and under the seal of this Honorable Court directed to the Supreme Court of the Philippine Islands demanding said Court to certify and send to the Supreme Court of the United States for its review and determination on a day certain to be therein designated a full and complete transcript of the record and of all proceedings in said Supreme Court of the Philippine Islands in the said case entitled "Carl Franz Adolf Otto Ingenohl, Plaintiff and Appellee, vs. Walter E. Olsen & Co., Inc., Defendant and Appellant, R. G. No. 22288", and that the judgment of said Supreme Court of the Philippine Islands may be reversed by this Honorable Court, and that your petitioner may have such other and further relief in the premises as to this Honorable Court may seem meet, and your petitioner will ever pray.

Dated, San Francisco,
July 11, 1925.

JOSEPH C. MEYERSTEIN,
Attorney for Petitioner.

In the Supreme Court
OF THE
United States

OCTOBER TERM, 1925

No.

CARL FRANZ ADOLF OTTO INGENOHL, *Petitioner,*

vs.

WALTER E. OLSEN & CO., INC., *Respondent.*

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI
to the Supreme Court of the Philippine Islands.

As the facts and grounds upon which the petitioner relies for writ of certiorari are briefly set forth in the petition, petitioner now presents this elaboration of the grounds.

I.

IT IS COMPETENT AND PROPER FOR THE SUPREME COURT OF THE UNITED STATES TO ENTERTAIN JURISDICTION IN THIS CASE.

(A) The Supreme Court of the United States has jurisdiction to review the decision of the Su-

preme Court of the Philippine Islands because the value in controversy exceeds $25,000.00. A part of the decision of the Supreme Court of the Philippine Islands is as follows:

> "That the defendant is the exclusive owner of the business of the plaintiff and his company as a going concern, and has absolute title and right to all of the trade marks in question and to their exclusive use and enjoyment not only in the Philippine Islands but in all other countries where they are duly registered." (Tr. pp. 393, 394.)

It appears from the answer of the respondent here, as filed in the Court of First Instance at Manila that the value of these trade marks *outside* of the Philippine Islands is 1,000,000 pesos. (Tr. p. 88.)

That the value in controversy exceeds $25,000.00 further appears from an affidavit of a competent witness made part of the record here.

(B) It is competent for the Supreme Court of the United States to review the decision of the Supreme Court of the Philippine Islands because there is involved a right or privilege of the United States in that Section 311 of the Code of Civil Procedure of the Philippine Islands by reason of the terms of which section the Court concluded that it could deny finality to the Hongkong judgment and reopen and retry the questions disposed of by the Hongkong judgment, is in conflict with the established policy and international law of the United States. Section 311 of the Code of Civil Procedure of the Philippine

Islands provides that a foreign judgment *in personam* "may be repelled by evidence of a want of jurisdiction, want of notice to the party, collusion, fraud or clear mistake of law or fact". The dissenting opinion of the Supreme Court of the Philippine Islands directs attention to the fact that this section was copied from Section 1915 of the Code of Civil Procedure of the State of California, and that a careful search fails to disclose any other similar statutory provision in the United States or elsewhere. It is interesting to note that Section 1915 of the Code of Civil Procedure of the State of California was amended and that as the section now stands a final judgment of a Court of a foreign country having jurisdiction according to the laws of such country to pronounce said judgment has the same effect as in the country where rendered and the same effect as final judgments in the State of California. The Code Commissioner's note in connection with the change in the California law is likewise interesting and it reads as follows:

> "The amended section gives full faith to foreign judgments. This also insures full credit to the judgments of our State courts in those foreign jurisdictions where such recognition of those judgments depends upon reciprocal recognition—see *Hilton v. Guyot,* 159 U. S. 113."

Undoubtedly it appeared to the Legislature of the State of California that this code section as it stood prior to 1907 conflicted with the policy and principle of the law of the United States as established by this Court. Section 311 of

the Code of Civil Procedure of the Philippine Islands remains unamended, and as it reads, does violence to the established policy and law of the United States. The principles to be observed in dealing with judgments of foreign Courts were clearly laid down in *Hilton v. Guyot, supra.* In the decision immediately following, namely *Ritchie v. McMullen,* 159 U. S. 235, the effort was made to go back of a Canadian judgment, and this Court said,

> "The defenses set up in the answer to this action upon the Canadian judgment reduce themselves to an attempt, without any sufficient allegation of want or jurisdiction of the cause or of the defendant, or of fraud in procuring that judgment or of any other special ground for not allowing the judgment full effect, but upon general allegations setting up the same matters of defence which were pleaded and might have been tried in a foreign court, to reopen and try anew the whole merits of the original claim in an action upon the judgment. This for the reasons stated in *Hilton v. Guyot, ante,* 95, cannot be allowed.
>
> Upon principle, therefore, as well as upon authority, comity requires that the judgment sued on should be held conclusive of the matter adjudged."

As stated by this Court in *Hilton v. Guyot,*

> "International law * * * including questions arising under what is usually called private international law, or the conflict of laws, and concerning the rights of persons within the territory and dominion of one nation by reason of acts, private or public, done within the dominions of another nation—is part of our law;"

As the Court there announced a principle for the guidance of all the Courts of the United States in their treatment of foreign judgments when sued upon in this country, the principles so announced become themselves part of our law; and manifestly a dependency of the United States cannot by statute overturn a principle of law so established. Assuredly it would hardly be contended that a section of the Philippine Code could stand as against either a treaty or a statute of the United States. In the absence of a treaty or statute of the United States, the decision of this Court upon a particular principle is the law of the land; and, it is submitted, it is not competent for a dependency to enact legislation clashing with the law of the mother country as so established. It would be strange if, after efforts extending over many years, the Courts of England and the United States had finally succeeded in clarifying and stating with precision a principle of reciprocal faith and credit to be attached to the judgments of their respective Courts, a dependency of one or the other could overturn a relationship so built up and established, by the act of a provincial Legislature, Commission or Court. The dissenting justices of the Philippine Supreme Court were not unmindful of the value of this contention, for they say (Tr. p. 418):

> "It may well be doubted if the government of the United States ever intended that the Philippine Commission, acting under war powers, should enact legislation at variance with the foreign policies and relations of the

> United States. It is questionable, if it is not beyond the power of the local legislature to provide peculiar legislation so entirely out of harmony with international comity. If forced to take the stand, we would debate long before holding that this provision in Philippine law is valid and constitutional.
>
> It is a most serious responsibility which this court assumes when it ventures to set at naught the full effect of reciprocity between two great states of the world, gravely acknowledged in both and fulfilled everywhere else in the two countries with the most scrupulous regard for the rights of the other".

As it is competent on two grounds for this Court to review the decision of the Supreme Court of the Philippine Islands, an invitation to do so ought to be considered sufficiently insistent in this case. It appears here, a large money value aside, that there are involved questions concerning the faith and credit to be given a judgment of a foreign Court, a question of private international law, and a question of the right of a dependency to enact legislation which clashes with the announced policies and principles of the mother country as declared by its Court of last resort.

II.

THE JUDGMENT OF THE SUPREME COURT OF THE PHILIPPINE ISLANDS IS ERRONEOUS.

Obviously, if the principles of *Hilton v. Guyot, supra,* and *Ritchie v. McMullen, supra,* are to rule

the decision with reference to the finality of the Hongkong judgment, and not Section 311 of the Code of Civil Procedure of the Philippine Islands, the judgment of the Supreme Court of the Philippine Islands is in error. In the opinion of the Supreme Court of the Philippine Islands this is admitted, for the court says, (Tr. p. 386):

> "Be that as it may, this court is bound by Section 311 of the Code of Civil Procedure. In so far as we are advised, the question here is one of first impression, and no other country has a like statute. That law was enacted by the legislature of the Philippine Islands and as to the Philippine Islands, it is the law of the land. *In the absence of that statute, no matter how wrongful the judgment of the Hongkong Court may be, there would be strong reasons for holding that it should be enforced by this court".* (Italics ours.)

But giving Section 311 its utmost force and effect the Hongkong judgment is still entitled to full faith and credit because, as will be clearly established, there was no mistake—clear or otherwise—of law or fact in the Hongkong proceedings or judgment.

We may pass by the erroneous finding of fact in the opinion of the Supreme Court of the Philippine Islands that Ingenohl was a German citizen and likewise the statement that the primary purpose of the proceedings on which the conveyance of the Alien Property Custodian was based, was,—"to wipe Ingenohl and his company out of existence"; although the desirability may be doubted of per-

mitting to remain standing as a binding principle of law, that Congress intended to wipe out the business of a Belgian or an American citizen unfortunate enough to have been detained during the War within the enemy lines. Likewise we may leave unchallenged the conclusion of the Philippine Supreme Court that the bill of sale as executed by the Alien Property Custodian undertook by its very terms to pass title to Ingenohl's trade marks everywhere. Nor need we linger over the point that there must be some distinction between a mistake of law or fact and a *clear* mistake of law or fact and that such mistake must appear on the record. A mistake can hardly be said to be clear when counsel and Courts and indeed two of the justices of the Supreme Court of the Philippine Islands differ as to the law. It will suffice to present the bald question,—If the judgment of the Hongkong Court is not final, is it right or wrong? And the answer to this question must be found in the answer to the question,—

Could or could not the Alien Property Custodian of the United States divest Ingenohl of his rights to trade marks appurtenant to and used in his factory in Hongkong and registered in the Colony of Hongkong?

It is clear that the Alien Property Law had no extra territorial effect. Neither did the act of the Alien Property Custodian, and this is true whether in his official capacity he undertook to deal with

tangible property or intangible, such as trade marks, because it is not unqualifiedly true that a trade mark is not limited in its enjoyment by territorial bounds. In *United Drug Co. v. Rectanus Co.,* 248 U. S. 90, it is said:

> "And the expression sometimes met with, that a trade-mark right is not limited in its enjoyment by territorial bounds is true only in the sense that wherever the trade goes attended by the use of the mark, the right of the trader to be protected against the sale by others of their wares in the place of his wares will be sustained";

and again in the same case it is said:

> "It is not contended, nor is there ground for the contention, that registration of the Regis trademark under either the Massachusetts statute or Act of Congress, or both, have the effect of enlarging the rights of Mrs. Regis, or of petitioner beyond what they would be under common law practice. *Manifestly the Massachusetts statute could have no extra territorial effect.*" (Italics ours.)

The case here is no different from that which was presented for the consideration of this Court in *Baglin v. Cusenier Co.,* 221 U. S. 580. There the business and trade marks of the Carthusian Monks in France were seized by an official liquidator for the French government; but as the Monks had removed to Spain, conducted their business there and used the trade marks in connection with the liqueur they manufactured, it was held that their right to do so in the United States could not be checked at the instance of the French liquidator. Here, it will

be borne in mind, that whether the Hongkong factory be considered as a branch of the Manila business, or of a business having its headquarters in Belgium, still it was a business without the territorial limits of the United States, a going concern and selling cigars under trade marks registered in Hongkong. Under these circumstances it did not lie within the power of the Alien Property Custodian in the Philippine Islands, nor within the power of the government of the United States, from which he derived his powers, to sequestrate and sell trade marks attached to a going business in another jurisdiction. As was stated in the *Chartreuse* case just cited

> "we are not concerned with their authority under the French law to conduct this business, but it is in the business to which the trademarks in this country relate. The business is being conducted according to the ancient process by the Monks themselves. *The French law cannot be conceived to have any extra territorial effect to detach the trade marks in this country from the product of the Monks which they are still manufacturing.*" (Italics ours.)

In the same case we find quoted with approval, the language of Lord McNaghten in the House of Lords in a similar case, *Lecouturier v. Rey* (1910), A. C. 265:

> "Of course in this country a trade mark can only be enjoyed in connection with a business, but I think that the Monks are carrying on a business in connection with which they can enjoy any trademarks to which they may be entitled and the labels which were put upon the

register and in respect of which the defendant Lecouturier has had his own name placed upon the register. Are those trademarks the property of the plaintiff? In my opinion they clearly are."

And, again in the *Chartreuse* case, *supra,* it is said:

"The Monks were enabled to continue their business because they still had the process. In continuing it they enjoyed all the rights pertaining to it, *save to the extent which by force of the local law they were deprived of their enjoyment in France.*" (Italics ours.)

Ingenohl was at all times manufacturing cigars and using in connection with that manufacture such skill and processes as belonged to him and his associates in Hongkong, and the product of his Hongkong factory was at all times being distributed in Hongkong, in China and in the Straits Settlements. If he, himself, had sold his Manila factory and trade marks and goodwill of the business there (and that is all the Alien Property Custodian could do), the purchaser there could not have interfered with Ingenohl's use of the marks in Hongkong or elsewhere, any more than Ingenohl himself could have interfered with the purchaser's marks in the Philippine Islands after such sale. A similar case was presented in *Bourjois & Co. v. Katzel,* 260 U. S. 689. There the French manufacturers of face powder packed under a distinctive mark, sold the American rights. The defendant bought a large quantity of the same powder in France and under-

took to resell it in the United States under a similar mark to that which had been acquired by the purchasers of the American rights. The American purchaser brought suit and enjoined such sale and in the decision it is said:

> "We are of the opinion that the plaintiff's rights are infringed. After the sale the French manufacturers could not have come to the United States and have used their old marks in competition with the plaintiff."

The converse of this must likewise be true. The American purchaser certainly could not have gone to France and have used the marks in competition with the French owner there, as long as the French owner remained in business there; nor could the American purchaser have used the marks in competition with the French owners in England or any other country where the French owners had them properly registered and continued to use them in their business. The case of *Koppel Industrial Car & Equipment Co. v. Orenstein, etc.,* 289 Fed. 446, relied on so strongly by respondent in the Supreme Court of the Philippine Islands, holds no more than the *Bourjois* case just cited. Both of these cases are, if anything, authorities which sustain the position of the petitioner here, for they clearly recognize the principle that the trade mark attached to a going business in a particular jurisdiction is property in that jurisdiction and is not affected either by a sale made by the owner himself limited to another jurisdiction or by the authority of the government of another jurisdiction. In conclusion it may perhaps be

stated that the question presented here cannot be more clearly presented than by stating it thus: Assume that the English Government acting through an Alien Property Custodian, or similar officer under a statute similar to our Alien Property Law, had seized and sold the Hongkong factory of Ingenohl and the trade marks appurtenant to it as registered in the Colony of Hongkong, could the purchaser of the Manila business have restrained the purchaser of the Hongkong business from using the trade marks registered in Hongkong in that Colony? To put it a little more strikingly, could the purchaser of the Hongkong business and the trade marks appurtenant to it, as registered in the Colony of Hongkong, have come into a Court of the Philippine Islands and have successfully restrained the purchaser of the Manila business and the trade marks appurtenant to it, from using those trade marks in the Philippine Islands?

In the light of the decisions of both this Court and the Court of Last Resort of England, the question practically answers itself.

For the reasons stated, it is submitted that the judgment of the Supreme Court of the Philippine Islands is in error and ought to be reversed.

Dated, San Francisco,
July 11, 1925.

Respectfully submitted,
JOSEPH C. MEYERSTEIN,
Attorney for Petitioner.

American Consular Service.

I, J. Cameron Hawkins, Vice Consul of the United States of America at Hongkong, duly commissioned and qualified, do hereby certify and make known to whom these presents may come that Michael Howard Turner, before whom the annexed affidavit hath been made was at the time of signing the annexed certificate, a notary public in and for the Colony of Hongkong, duly authorized to administer oaths and affirmations and to take declaration in lieu of oaths, and that I believe the deponent is worthy of credit and qualified to verify the annexed affidavit.

In witness whereof I have hereunto set my hand and seal of office at Hongkong, aforesaid, this 30th day of May, 1925.

(Seal) J. CAMERON HAWKINS,
Vice Consul of the United
States of America.

Cancelled revenue stamp
Jun. 4, 1925
Fee No. 1417

In the Supreme Court
OF THE
United States

OCTOBER TERM, 1925

No.

CARL FRANZ ADOLF OTTO INGENOHL,
Petitioner,

vs.

WALTER E. OLSEN & CO., INC.,
Respondent.

AFFIDAVIT OF H. SIELING AS TO AMOUNT INVOLVED IN DISPUTE,

On Petition For Writ of Certiorari to the Supreme Court of the Philippine Islands.

City of Victoria,
Colony of Hongkong.—ss.

I, Herman Sieling, of the City of Victoria in the Colony of Hongkong of lawful age make oath and say as follows:

1. I am the duly appointed agent and attorney by deed of the above named Carl Franz Adolph Otto Ingenohl and have been in charge of the busi-

ness carried on by the said Carl Franz Adolph Otto Ingenohl in Hongkong under the style of the Orient Tobacco Manufactory since the year 1908, and I am therefore thoroughly conversant with all matters appertaining to the said business and in particular am familiar with the trade-marks which are the subject matter of the controversy in the above entitled cause, namely the said trade-marks consisting (inter alia) of "La Perla del Oriente", "El 'Cometa' del Oriente" and "Imperio del Mondo".

2. The said trade marks have been used in the aforesaid business in Hongkong by the said Carl Franz Adolph Otto Ingenohl since the year 1910 and in my opinion such trade marks are now worth more than $25,000 United States currency to wit —not less than $250,000 United States currency.

H. SIELING.

Subscribed and sworn before me this 29th day of May, 1925.

(Seal) Michael H. Turner,
Notary Public,
Hongkong.

Revenue stamps

To all to whom these presents shall come, I Michael Howard Turner, Notary Public, duly authorized, admitted and sworn, residing and practising at Victoria in the Colony of Hongkong do hereby certify that Herman Sieling the person named in the affidavit hereunto annexed was duly sworn to the truth thereof before me and by me on the date thereof and that the signature "H. Sieling" thereto subscribed is in the proper handwriting of the said Herman Sieling and that the signature "Michael H. Turner" is in the proper handwriting of me the said Notary.

In testimony whereof I have hereunto subscribed my name and affixed my seal of office this twenty-ninth day of May in the year of our Lord one thousand nine hundred and twenty-five.

(Seal) MICHAEL H. TURNER,
Notary Public,
Hongkong.

In the Supreme Court
OF THE
United States

OCTOBER TERM, 1925

No.

CARL FRANZ ADOLF OTTO INGENOHL,
Petitioner,

vs.

WALTER E. OLSEN & CO., INC.,
Respondent.

AFFIDAVIT OF MAILING NOTICE.

State of California,
City and County of San Francisco.—ss.

Joseph C. Meyerstein, being first duly sworn, deposes and says:

That he is an attorney at law and is the attorney of record for the above named petitioner in the above entitled cause and that he resides at the City and County of San Francisco, State of California, and has his office at No. 57 Post Street in said City and County of San Francisco, State aforesaid; that

Messrs. Gibbs and McDonough are the attorneys of record for the above named respondent in said cause, and that they reside in the City of Manila in the Philippine Islands, and have their office at 302 Roxas Building, in said City of Manila, Philippine Islands; that in each of said two places there is a Post Office, and between said two places there is regular communication by United States Mail; that on the 11th day of July, 1925, deponent served a true copy of the petition for writ of certiorari to the Supreme Court of the Philippine Islands, of the motion for writ of certiorari from the Supreme Court of the United States to the Supreme Court of the Philippine Islands, of the notice of application to the Supreme Court of the United States for writ of certiorari, and of the brief in support of petition for writ of certiorari as annexed hereto, on said Messrs. Gibbs and McDonough, the said attorneys for said respondent, by depositing a copy of said motion for writ of certiorari and of said notice of application for said writ of certiorari, and of said petition for writ of certiorari and the brief in support thereof on said date in the United States Post Office at the said City and County of San Francisco aforesaid properly enclosed in an envelope addressed to the said Messrs. Gibbs and McDonough, attorneys at law, at 302 Roxas Building, Manila, Philippine Islands, the office of said attorneys for respondent, and prepaying the postage thereon.

JOSEPH C. MEYERSTEIN.